

## REMARKS

Claims 1-22 are pending in the present application. Claims 1-22 have been rejected. No claims have been allowed. Claims 1-9, 11-12, 14-20 and 22 have all been amended solely for purposes of clarification such that no narrowing of claim scope to overcome any prior art has been accomplished. No claims have been canceled or added.

### **I. Requirements for Information under 37 CFR § 1.105**

The Office Action has set forth a Requirement for Information under Rule 105, requiring in particular, “information used in drafting the present operation including information related to the field of endeavor or business practices used by applicants’ professional business ventures, to show the information used in the invention process, and identification of any use of the claimed invention known to the inventor at the time the application was filed notwithstanding the date of use.” The Office Action then asserts, *inter alia*, “the application is filed as a small entity status.”

As an initial matter, Applicant respectfully points out that no claim of small entity has ever been made in this case, that various assignments to International Game Technology and IGT (collectively “Assignee”) were filed both contemporaneously with the filing of this application as well as subsequently, and that all fees have been timely paid in full at large entity rates. Accordingly, a withdrawal of the mischaracterization of this application as being filed under small entity status is respectfully requested.

In responding to the Requirement for Information, Applicant first notes that the present application does not claim the broad concept of a voucher system in general, but rather is directed toward a specific system and method used in association with *gaming machines* that *accept* (not just dispense) *cash* vouchers. The invention finds particular application in the

context of *sorting* and *reconciling* vouchers. Indeed, even the title of the present application confirms such a specific scope. Actual claim elements (not all found in a single claim) include the use of a gaming machine, the acceptance of cash vouchers by the gaming machine, the generation of records upon the acceptance of cash vouchers, comparing and/or reconciling retrieved cash vouchers with records generated from the acceptance of cash vouchers, the acceptance of bill monies at the gaming machine, and the sorting of cash vouchers from bill monies, among others.

Because no method or system having the claimed combinations of the foregoing elements existed prior to the present invention, Applicant notes that little prior art relevant to the invention may exist. As indicated in the Background section of the present application, gaming machines have been configured to accept bill monies for many years. Gaming machines that could dispense tickets representing winnings first appeared in the 1990s, although such machines could only issue (i.e., not accept) such tickets. The Assignee began developing gaming machines that could both issue and accept tickets in or about 1999, with these tickets or cash vouchers usable within a gaming system in the same sense as bill monies. This system suffered initial practical implementation issues, however, in that contemporary gaming machines were only configured to accept and store bill monies. The present invention solved this problem by developing methods and systems whereby both bill monies and cash vouchers can be accepted, credited and recorded at a gaming machine, and can then be retrieved and reconciled at some later time. Sorting may occur at the gaming machine, during a subsequent soft count process, or both.

Paramount to any practice of this invention is the use of a gaming machine that accepts cash vouchers (which gaming machine may issue such cash vouchers as well). Applicant is unaware of the existence of such a gaming machine prior to that which was developed and

introduced to market by Applicant and others employed by the Assignee. To the best of Applicant's knowledge, the first public use, display or offer for sale by Applicant or Assignee of such a gaming machine adapted to accept cash vouchers was made at the annual Global Gaming Expo ("G2E") trade show in Las Vegas, Nevada on September 27, 1999. Accordingly, any public use or offer for sale of the claimed invention cannot possibly predate this trade show. The 1999 G2E trade show does not necessarily constitute a public use, display or offer for sale of the Applicant's claimed invention, however, as it is believed that disclosure of all claim elements in the claimed methods and systems may not have been made at this event. In fact, it is believed that a more complete offer for sale, sale and implementation of Applicant's claimed invention may not have been made until January of 2000 at the Fiesta Hotel and Casino in Las Vegas, Nevada. Accordingly, Applicant was well within the one-year grace period after the first public use or offer for sale of the invention for filing a patent application on his invention.

With respect to the specific Requirement for Information regarding information used in the drafting of the application, Applicant responds that the present application was prepared primarily from disclosures provided by Applicant to the attorneys that drafted and filed the application. In particular a 3-page written disclosure dated May 24, 2000 was used for the preparation of this application. This document, titled "IGT Invention Disclosure," is attached hereto as Exhibit A. Also used in the drafting of this application was a powerpoint presentation entitled "International Game Technology, EZ Pay Ticket System, IVS, Integrated Voucher System, System Overview." This powerpoint presentation is attached hereto as Exhibit B. To the best knowledge of those involved in the drafting of this application, no other materials outside of this disclosure and powerpoint presentation were used.

With respect to the specific Requirement for Information regarding other information, such as that relating to other patents and pending applications by Applicant, Applicant has submitted a Supplemental Information Disclosure Statement (“IDS”) herewith. Although a total of 66 references are recited therein, virtually all of these references are merely those that are of record in the two issued patents and four pending applications upon which all double patenting rejections in the present Office Action are based. Although several of these issued patents and pending applications are not believed to be material with respect to the presently claimed invention, Applicant earnestly believes that the exclusion of any reference of record in any of these other cases would now be imprudent in light of the pending double patenting rejections. In addition, a corresponding foreign patent application claiming priority to the present application was filed in Canada. The Canadian Intellectual Property Office conducted a search and located several references, which references are also cited in this Supplemental IDS. Applicant notes that the claims of the counterpart Canadian application are substantially identical to the claims as filed in the present case, and that the Canadian Intellectual Property Office has already found most of these claims to be allowable.

With respect to other potential categories within the pending Requirement for Information, Applicant did not conduct any pre-filing search, is unaware of any commercial databases with information regarding the invention, and believes this invention to be an improvement only in the sense that it now allows a gaming machine to accept a cash voucher and provides for desirable sorting and reconciliation functions that arise thereby. In fact, such a gaming machine is not believed to have existed prior to the present invention. Accordingly, it is believed that the present Requirement for Information has been appropriately addressed in all regards in light of that which has been required. If the present response is deemed insufficient in

any way, or if additional information is required for any reason, however, then additional information can be provided upon a notice to that effect and a further detailed Requirement.

## II. Claim Rejections under 35 U.S.C. § 101

Claims 1-8 and 14-16 stand rejected under 35 U.S.C. § 101 as not reciting a useful, concrete and tangible result. In particular, the Office Action states, “The independently claimed invention is an abstract idea which can be performed without interaction of a physical structure [and that the claimed steps] can be performed by personal skills . . . without a physical structure or mechanical object.” Applicant respectfully traverses these § 101 rejections.

Applicant respectfully submits that all claims as filed meet the statutory requirements of Section 101, and that these claims do indeed require the use of or interaction with one or more physical structures or mechanical objects. For example, independent Claim 1 as filed requires the steps of accepting at least one *voucher* at a *gaming machine*, and storing *vouchers* in and retrieving *vouchers* from that *gaming machine*. Other physical structures and mechanical objects from other claims as filed include, *inter alia*, bill monies, bar codes, data storage elements, sorting mechanisms, scanners, high speed scanners, reject areas, generated images, hand-held scanners, storage containers, computing devices, laser-beam scanners and computers.

Although it is believed that more than enough physical structures and mechanical objects have been recited in all claims as filed so as to provide useful, concrete and tangible results under Section 101, the pending claims have been amended to clarify that which is being claimed. In particular, the preamble of every independent claim now recites a gaming machine, such that use of a gaming machine and/or gaming system is specifically required for all claims. Although cumulative, further clarifying amendments have also been made where applicable to require that

cash vouchers and bill monies be accepted *by* and not simply at such gaming machines. Again, it is respectfully submitted that such amendments have not served to narrow the scope of the pending claims, but rather have simply clarified that which is being claimed. Because these clarifying amendments result in the clear requirement of a gaming machine that accepts cash vouchers as a part of all claimed methods and systems, Applicant respectfully submits that any perceived issues with respect to 35 U.S.C. § 101 have been obviated.

### **III. Claim Rejections under 35 U.S.C. § 112, First Paragraph**

Claims 1-22 all stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter not described in the specification in such a way so as to enable one skilled in the art to practice the invention. In particular, the Office Action recites several claimed steps and then states, “The independently claimed invention specifically reciting those steps is considered non-enabling because the specification does not provide a concrete example or illustrating of those claimed steps.” Applicant respectfully traverses these enablement rejections under Section 112, first paragraph.

Applicant first notes that the specification only needs to be enabling to one of ordinary skill in the art, such that extraneous details regarding mundane details of known components or steps are not necessary. In fact, since a working example is not necessary under the enablement requirement, it certainly cannot be said that concrete examples for every step and claim element are necessary under this requirement. *See, e.g.*, MPEP § 2164.02. Rather, the true test of enablement is whether the disclosure is sufficient to enable one skilled in the art to practice the invention without undue experimentation. *See* MPEP § 2164.01. Applicant respectfully submits that such a person would readily understand the various principles contained in the present

disclosure and invention as claimed, such that one of ordinary skill in the art would be able to practice the invention without undue experimentation.

In so submitting, Applicant points out that the application provides a great deal of detail regarding the steps and elements contained in the claims. For example, regarding the step of “generating a record regarding accepted vouchers,” sufficient description is provided at page 13, lines 4-14 of the specification, wherein one embodiment a gaming machine may include a validating mechanism that reads information from a voucher. That information is sent to a central host that stores voucher information. The validity of the voucher is confirmed, along with its value, the associated value is credited by the gaming machine, and a transaction record regarding the credit value is generated or updated. Further, regarding the steps of “comparing information regarding retrieved vouchers and accepted vouchers” and “determining if a total value of vouchers and bills comprises a total value credit for an accepted voucher or bill,” sufficient description is provided at page 14, lines 12-19 of the specification, where the invention includes determining if the value of the monies and vouchers retrieved from the gaming machine reconcile with the value of the monies and vouchers received and credited by the gaming machine. As further described at page 17, lines 16-24, in this comparing or “reconciliation” step, the sum of the values of the vouchers retrieved from the gaming machine is compared to the values of the vouchers paid or credit by the gaming machines. In yet another example, the element of a “sorting mechanism” is sufficiently described from page 15, line 6 to page 16, line 15, wherein details are given of multiple configurations of sorting mechanisms, including references to existing technology that may be used or modified to perform the desired sorting.

As a final note, Applicant respectfully submits that the burden of establishing a proper enablement rejection under 35 U.S.C. § 112, first paragraph has not been met in the contents of

this Office Action. In particular, the only reasoning within the Office Action as to the uncertainty of the enablement appears to be conclusory in nature, where concrete reasons and analysis with respect to at least some relevant undue experimentation factors are required. *See, e.g.*, MPEP § 2164.04. For each of the foregoing reasons, Applicant respectfully submits that the present claims are enabled by the written description, and respectfully requests the withdrawal of these § 112, first paragraph rejections.

#### **IV. Claim Rejections under 35 U.S.C. § 112, Second Paragraph**

Claims 1-22 all stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. In particular, the Office Action states, “The independently claimed steps specifically reciting [a list of claimed] features are considered indefinite because the specification does not provide an antecedent basis of those steps.” Applicant respectfully traverses these indefiniteness rejections under Section 112, second paragraph.

Applicant respectfully submits that each and every claim as filed and as presently amended complies with Section 112, second paragraph. Applicant first notes that a claim term that has no antecedent basis in the disclosure is not necessarily indefinite. Rather, the test is whether the terms and phrases used to define the invention are reasonably clear and precise. *See, e.g.*, MPEP § 2173.05(e). The terms and phrases used by Applicant in the claims are not unclear or imprecise, and it should be apparent that anyone readily skilled in the art would understand that which is being claimed. Furthermore, as discussed above, the written description as filed *does* specifically detail the invention as claimed, including terminology and description for each specifically recited step, item and claim element. In sum, Applicant respectfully submits that the

present claims are not indefinite due to lack of antecedent basis in the specification, and thus respectfully requests the withdrawal of these § 112, second paragraph rejections.

#### **V. Claim Rejections under 35 U.S.C. § 102(a)**

Claims 1-22 stand rejected under 35 U.S.C. § 102(a) as being anticipated by applicant's specification. In particular, the Office Action states, "the claims contain the same subject matter as the specification background and since the background is normally admitted prior art, the claims and claims depending upon them are considered anticipated by the specification admitted prior art." Applicant respectfully traverses these Section 102(a) rejections.

Applicant initially acknowledges that the Background section of the present application does indeed discuss the state of the prior art. As indicated, prior art gaming machines were configured to accept bill monies as the basis of player wagers, with these bill monies being stored in cash boxes and collected from the gaming machines at various intervals. As first discussed in the final paragraph at the end of the Background section at page 3, lines 17-21, however, the present invention does differ from the prior art in several regards. Applicant respectfully submits that although a discussion of the present invention within the Background section may not be stylistically preferable to some, such a mention does not automatically legally transform all that is discussed therein into admitted prior art. Rather, a rational and reasoned approach can be taken with respect to any portion of a Background section that may involve some aspect of the disclosed and claimed invention.

In this case, however, it is clear and unambiguous that the final paragraph of the present Background section discusses only the present invention and no prior art. In particular, this final paragraph begins with the phrase, "In accordance with the *present invention*," and then proceeds

to list advantages and features of the present invention. Furthermore, this paragraph is clearly a transition paragraph from the foregoing prior art to the Summary section that directly follows. A clearer case for a discussion involving the presently claimed invention within a Background section could not be had. It appears, however, that the present admitted prior art rejections must be based upon the contents of this final paragraph of the Background section. As explained above, this paragraph in no way, shape or form contains any admitted prior art. Accordingly, Applicant respectfully requests the withdrawal of these § 102(a) rejections.

## **VI. Claim Rejections under 35 U.S.C. §§ 102(b) and 102(e), Anticipation**

Claims 1-22 stand “rejected under 35 U.S.C. 102(b) as being clearly anticipated by Koropitzer et al. (US 5,694,323) or Baker et al. (US 5,884,292) and are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Walker et al. (US 6,208,978) or Leason et al. (US 6,251,017).” In particular, the Office Action provides no analysis or characterization of any of these references, no discussion of a single element of any of the 22 rejected claims with respect to any of these references, and no additional explanation whatsoever. Applicant respectfully traverses these rejections.

“The goal of examination is to clearly articulate any rejection early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity.” MPEP § 706. “In rejecting claims for want of novelty[, w]hen a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.” 37 CFR § 1.104(c)(2). The present rejections under Koropitzer, Baker, Walker

and Leason could not possibly be more vague or cursory in nature. It is not clear to Applicant why any of these references has been cited, or what part or parts of any of these references are deemed to be particularly relevant. Further, it is indisputable that each reference “shows or describes inventions other than that claimed by the applicant,” and that several references are fairly complex and lengthy. Accordingly, Applicant respectfully submits that the content within the Office Action does not meet the burden required for rejecting claims for want of novelty.

In the interests of responding to the best of his ability under the circumstances, Applicant also respectfully submits that none of these references discloses or suggests a gaming machine, much less a gaming machine arranged to accept cash vouchers, as claimed in the present invention. Other material claim elements also appear to be missing from each of these recited references, although further discussion would be merely cumulative at this point. Because none of these references contains the material elements of at least a gaming machine or a gaming machine arranged to accept cash vouchers, none of these references can possibly be said to anticipate any of the present claims. Accordingly, Applicant respectfully requests the withdrawal of these § 102(b) and § 102(e) rejections.

## **VII. Claim Rejections under 35 U.S.C. § 102(b), Public Use or On Sale Bar**

Claims 1-22 stand rejected under 35 U.S.C. § 102(b) based upon a public use or sale of the invention. In particular, the Office Action states, “An internet search and a trademark database search has revealed that the claimed invention has been in public use or on sale for more than one year from the filing of the present invention. The first named inventor was involved in a business venture [and] admit[s] that the claimed invention was in public use as

early as 1994 (through federally registered trademarks)." Applicant respectfully traverses these rejections and categorically denies that such a public use was even possible.

Applicant initially notes its disadvantage to respond to the particular issues raised by the Office Action here, since none of the information relied upon as the basis for these rejections has been provided to the Applicant. For example, no identification has been provided for the particular "business ventures" or "trademarks" that allegedly provide evidence of the public use of the invention. Although currently unknown, it is believed that such particular "business ventures" or "trademarks" may relate to gaming machines that dispense or issue tickets or cash vouchers, which indeed did exist prior to 1999.

As indicated above, however, the present invention involves, *inter alia*, gaming machines that also *accept* cash vouchers and that also provide for the sorting and reconciliation of such accepted cash vouchers. As also indicated above, the first public use or offer for sale by Applicant and/or Assignee of such a gaming machine that accepts cash vouchers occurred no earlier than September 27, 1999. The various business ventures and trademarks alluded to in the Office Action must therefore have no known relationship to the present invention, but must rather relate to other methods and systems. Further details can be given upon an identification of the exact business ventures and trademarks of concern.

The Office Action further adds that "additional information regarding this issue is required as follows: the earliest release date and availability of the above mentioned trademark by the assignee of the claimed invention." With regard to this added requirement, Applicant notes that no such trademark is specified anywhere within the Office Action. The Assignee, however, is the owner of hundreds of federally registered trademarks, as well as a myriad of other unregistered marks, many of which relate to gaming machines and cash voucher methods

and systems. Again, details regarding a specific Assignee trademark can be given upon an identification of the exact trademark of concern.

### **VIII. Claim Rejections under 35 U.S.C. § 103**

“Claims 1-22 are rejected under 35 U.S.C. § 103(a) as being unpatentable over an obvious variation of examiner’s personal experience . . . as a Metro farecard user of the Washington Metropolitan Area Transit Authority (WMATA).” Applicant respectfully traverses these rejections.

Applicant initially submits that WMATA is entirely non-analogous art with respect to the field of invention (i.e., gaming machines), and is thus not subject matter to which one of ordinary skill in the art would look when considering the present invention or the problems solved by the present invention. Furthermore, as best understood by Applicant, WMATA fare cards are not sufficiently similar to the cash vouchers of the presently claimed invention. The cash vouchers of the present invention are exactly that, cash vouchers. That is, they can be bought with cash and *redeemed for cash*. It is not believed that WMATA fare cards can be redeemed for cash, such that these items are not cash vouchers. Any ambiguity as to the nature of the claimed cash vouchers being exchangeable for cash, and vice-versa, has been overcome through the present amendments clarifying that all such vouchers are indeed cash vouchers, the designation of which is fully supported in the written description.

In addition, it does not appear that WMATA turnstiles accept bill monies, nor then do the turnstiles or other elements of the system accept both vouchers and bill monies and store them, including in commingled fashion in a container. It also appears that the sorting of commingled fare cards and bill monies does not necessarily occur, and such sorting indeed cannot occur

unless bill monies and fare cards are commingled in the first instance. Furthermore, the reconciliation of such fare cards and bill monies may also not occur. Certainly all motivations for reconciling accepted cash and instruments with retrieved cash and instruments will not be identical between a private gaming casino and a public transit authority, which further detracts from any proper finding of obviousness.

Because WMATA has not been shown to contain the material elements of at least a gaming machine, a cash voucher, a gaming machine arranged to accept cash vouchers, a machine that accepts and commingles bill monies and cash vouchers, a system or method that sorts cash vouchers from bill monies or a system or method that reconciles cash vouchers, among others, the WMATA fare card system cannot possibly be said to anticipate any of the present claims. Because WMATA is not a gaming system and does not include cash vouchers or other similarly redeemable instruments, it is clearly so analogous to the field of the present invention so as to be incurable in its many defects with respect to these multiple missing material claim elements. Accordingly, Applicant respectfully requests the withdrawal of these § 103 rejections.

Although these obviousness rejections are believed to have been properly traversed, Applicant respectfully requests that the Examiner provide detailed facts regarding the operation of the WMATA in the event that the rejection is maintained. Such detailed facts can be provided, for example, via a declaration in accordance with MPEP § 2144.03. Such a request is proper in that Applicant submits that the cited prior art is not of the type that is “well-known,” and the Examiner admits that the citation is based upon personal knowledge. If possible, documentary evidence regarding the operation of the system would be appreciated.

## **IX. Claim Rejections Under Double Patenting**

“Claims 1-22 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-19 of US Patent 6,406,023 [Exhibit C] or as being unpatentable over claims 1-45 of US Patent 6,394,907 [Exhibit D].” In addition, “Claims 1-22 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-65 of copending application 09/993,163 [Exhibit E], as being unpatentable over claims 1-38 of copending application 10/044,218 [Exhibit F], as being unpatentable over the pending claims of copending application 09/554,884 (sic, 09/544,884) [Exhibit G], or as being unpatentable over claims 1-38 [now 1-37] of copending application 09/924,250 [Exhibit H].” In particular, the Office Action states, “Although the conflicting claims are not identical, they are not patentably distinct from each other because the present application contains the an obvious variation recitation in claim language as applied to the copending application. The present application and each of the patented inventions perform the same function in the same way with the same result.” Applicant respectfully traverses these rejections.

As an initial matter, Applicant notes that each asserted patent and pending application is commonly owned and assigned by the present Assignee. Applicant is fully prepared to provide a timely terminal disclaimer with respect to any such patent or pending application that is shown to merit a proper double patenting rejection in light of any eventually allowable subject matter in the present application.

With respect to the pending claims of the present application and the present claims of each of these patents and other applications, however, Applicant is entirely unclear as to how any of the current double patenting rejections can be properly maintained. Applicant again refers to

the guidelines and rules recited in MPEP § 706 and 37 CFR § 1.104(c)(2), and respectfully submits that the content within the Office Action does not meet the burden required for rejecting the present claims for want of novelty or for obviousness in light of these other identified patents and applications commonly owned by the Assignee. Further, Applicant respectfully submits that the imposition of Applicant to characterize and potentially inappropriately narrow the scope of any of these other patents and pending applications owned by Assignee is unreasonable in light of the lack of specificity of the double patenting rejections as currently recited.

In the interests of again responding to the best of his ability under the circumstances, however, Applicant also respectfully submits that none of these other patents or pending applications appear to claim subject matter in such a way so as to result in an improper instance of double patenting. For example, the issued claims of the '023 patent cover a method of playing blackjack with multiple hands, and although certainly possible, never *require* the use of a gaming machine adapted to accept cash vouchers. As another example, the issued claims of the '907 patent cover a cashless transaction clearinghouse and although certainly possible, similarly never *require* the use of a gaming machine adapted to accept cash vouchers. In yet another example, the pending claims of the '163 application similarly cover a cashless transaction clearinghouse and never *require* the use of a gaming machine adapted to accept cash vouchers. In fact, each of the remaining three applications similarly contain no claims that specifically *require* the use of a gaming machine adapted to accept cash vouchers. Of course, it goes without saying that the claims of these applications may cover a use involving such a device. However, this is not the appropriate test for a double patenting rejection based on novelty or obviousness, as this material element is missing from every claim of each of these other patents and pending applications. Accordingly, Applicant respectfully requests the withdrawal of these double patenting rejections.

## CONCLUSION

Applicant respectfully submits that all claims are in proper form and condition for patentability, and requests a Notification of Allowance to that effect. A check covering the fee for the accompanying three-month Petition for Extension of Time is submitted herewith. The fee for the concurrently filed Supplemental Information Disclosure Statement has already been paid via the portion of the Statement that was E-filed today. It is believed that no other fees are due at this time. Should the check for the Petitioner for Extension of Time be inadvertently omitted, or should any other fee be required for any reason related to this document, then the Commissioner is hereby authorized to charge said fee to Deposit Account No. 50-0388, referencing Docket No. IGT1P116. The Examiner is respectfully requested to contact the undersigned attorney at the telephone number below with any questions or concerns relating to this document or application.

Respectfully Submitted,  
BEYER WEAVER & THOMAS, LLP

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